

R E M A R K S

Claims 4 and 5 are amended. Claims 1-3 and 6 are withdrawn from consideration. Claim 7 stands as originally filed. The title is amended to make is consistent with the elected claims. Reconsideration and reexamination are requested.

In the office action, paper number (unspecified), dated November 9, 2004, the examiner noted applicants previous election without traverse of the Group II claims and species A.

The examiner rejected claims 4 and 5 under 35 U.S.C. §102(b) as being anticipated any of Margen, U.S. Patent No. 3,406,092 (Morgen I); Dietrich, *et al.*, U.S. Patent No. 3,855,060 (Dietrich); Treshow, U.S. Patent No. 3,957,577 (Treshow); or Germer, U.S. Patent No. 4,769,208 (Germer). The examiner rejected claims 4 and 7 as being anticipated by either Michel, U.S. Patent No. 3,123,532 (Michel) or Parkinson, *et al.*, U.S. Patent No. 3,228,847 (Parkinson). The examiner also rejected claims 4, 5, and 7 as being anticipated by either Margen, German Patent No. 2,047,253 (Morgen II) or Ablitt, U.K. Patent No. 969,089 (Ablitt). The examiner rejected claims 4, 5, and 7 under 35 U.S.C. §112, second paragraph, as being indefinite for the reasons stated in Section 10 of the office action.

Re the Restriction Requirement:

Applicants affirm the election of the Group II invention, species A. The claims readable thereon are 4, 5, and 7. Applicants note that claim 4 is generic for Group II.

Re the Section 112 Rejections:

The examiner rejected claims 4, 5, and 7 under Section 112, second paragraph for the

reasons stated in Section 10 of the office action. With respect to the first two reasons, i.e., the term “scramming position” and to the last two lines of claim 4, the amendments to the claims have eliminated this term and the last two lines of claim 4. Consequently, these rejections are moot and will not be addressed further.

With regard to the examiner’s rejection of claim 5 for the phrase “using primarily a static pressure component of the pressure differential,” applicants respectfully traverse the rejection in that this phrase is sufficiently definite under Section 112. That is, a person having ordinary skill in the art would readily understand the meaning of the phrase when read in light of the specification. For example, paragraph 55 describes the static pressure component and the that the lift force exerted on the control element is a function of the pressure differential and the area of the control element that is presented to the pressure differential. In addition, applicants note that the identical phrase was allowed in claims 5 and 11 of the parent application, now U.S. Patent No. 6,804,320. The presence of the same phrase in an issued U.S. patent is prima-facie evidence that the phrase is sufficiently definite under Section 112 as a matter of law. Accordingly, applicants assert that the phrase as identically used in pending claim 5 is prima-facie definite under Section 112, second paragraph.

Legal Standard For Rejecting Claims
Under 35 U.S.C. §102

The standard for lack of novelty, that is, for “anticipation,” under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. Scripps Clinic & Research Foundation v. Genentech,

Inc., 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in “whereby,” “thereby,” and “adapted to” clauses cannot be disregarded. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871 (Fed. Cir. 1990).

Re the Section 102 Rejections of Claims 4, 5, and 7:

Claims 4 and 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by any of Margen I, Dietrich, Treshow, or Germer. Claims 4 and 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by either Michel or Parkinson. Claims 4, 5, and 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by Margen II or Ablitt.

With respect to the amended claims, each of claims 4, 5, and 7 requires positioning a guide tube within a core of the nuclear reactor so that the various sections thereof, i.e., the elongated inlet section, the substantially straight control element section, the first U-shaped section joining the inlet section and control element section; the outlet section, and the second U-shaped section joining the control element section and the outlet section are positioned within the core in the manner described in amended claim 4. None of the prior art references disclose or suggest a method that involves positioning a guide tube within the core of a reactor that meets the specific limitations set forth in the amended claims. Therefore, none of the references can anticipate claims 4, 5, and 7.

In addition, claims 4, 5, and 7 require using the coolant pressure differential to hold the control element at about an upper position within the control element section of the guide tube (e.g., during normal operation), yet fall under the action of gravity if the coolant pressure differential drops below a safe level. While some the prior art references disclose a similar arrangement, none of the prior art references disclose or suggest the positioning of a guide tube within the core that meets the limitations of the amended claims. Absent such a disclosure or suggestion, it cannot be said that the prior art references would make obvious the arrangement of the amended claims. Consequently, claims 4, 5, and 7 cannot be said to be obvious over the prior art.

Applicants believe that all of the claims pending in this patent application are allowable

and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

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